

REMARKS**I. General**

Claims 1-63 are pending in the present application. Claims 57-63 have been allowed. Applicant wishes to thank the Examiner for the indication that dependent claims 2-22, 36, 40-46, and 55 would be allowable if rewritten in independent form. The outstanding issues in the current application are as follows:

- Claims 1 and 39 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting;
- Claims 47-54 and 56 stand rejected under 35 U.S.C. § 102(e) as unpatentable over Elliott, U.S. Pat. No. 6,614,781 (hereinafter *Elliott*);
- Claims 23-33, 37 and 38 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Elliott* in view of Cave, U.S. Pat. No. 5,754,631 (hereinafter *Cave*); and
- Claims 34 and 35 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Elliott* and *Cave* in view of Blair, U.S. Pat. No. 6,404,857 (hereinafter *Blair*).

Applicant hereby traverses the outstanding rejections of the remaining claims, and requests reconsideration and withdrawal of the outstanding rejections in light of the remarks contained herein.

II. Applicant's Record under § 713.04 of Telephone Interview with Examiner

Applicant respectfully submits the following record of the telephone interview of October 24, 2005, under M.P.E.P. § 713.04. The following persons participated in the interview: Examiner John Shew and Applicant's attorney, Jerry L. Mahurin, Registration Number 34,661. The Examiner confirmed that independent claims 1 and 39 were allowable, but for the provisional obviousness-type double patenting rejections.

III. Double Patenting Rejections

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of co-pending U.S. Pat. App.

Ser. No. 09/772,645 in view of *Elliott*. Claim 39 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over co-pending U.S. Pat. App. Ser. No. 09/772,645. In response, Applicant proposes filing a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(b), or otherwise responding, if these rejections still stand upon an indication of allowability on all other matters. Therefore, Applicant respectfully submits that these rejections should be deferred until a later time.

IV. Rejections under 35 U.S.C. § 102(e)

Claims 47-54 and 56 stand rejected under 35 U.S.C. § 102(e) as unpatentable over *Elliott*. Applicant respectfully traverses these rejections.

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. § 2131, citing *In re Bond*, 15 US.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejection does not satisfy one or more of these requirements.

Independent claim 47 recites, in part, “interfacing an operator system to said interactive response process” The Office Action states that:

Elliott teaches . . . interfacing an operator system to said interactive response process (FIG. 6C, column 42, lines 56-59) referenced by IVR services provided off-switch similar to operator services. Office Action, page 9.

However, FIG. 6C of *Elliott* clearly shows that operator services 628 and calling card IVR 632 are separate entities that are not at all interfaced. While *Elliott* indicates that “[o]perator services can be available to any customer using . . . calling card service . . . of the carrier of telecommunications network 200,” there is no teaching or suggestion of interfacing an operator services 628 with calling card IVR 632. *Elliott*, col. 223, lines 13-19.

In response to Applicant's previous remarks along this line of reasoning, the Office Action stated that "[i]t is clear that [*Elliott's* calling card service and operator service] can be integrated as one system as opposed to two separate systems." Office Action, page 28 (emphasis added). However, in order for a cited reference to be anticipatory, the identical invention must be shown in as complete detail and the elements must be arranged as claimed, see M.P.E.P. § 2131. Therefore, the mere assertion that prior art elements can be arranged as claimed does not provide appropriate support for a § 102 rejection. Accordingly, Applicant respectfully asserts that the rejection of independent claim 47 under 35 U.S.C. § 102 is improper and that for at least the reasons advanced above claim 47 is patentable over the § 102 rejection of record.

Claim 47 further recites, in part, "establishing a first signaling channel associated with said first communication device and said interactive response process" The Office Action states that:

Elliott teaches . . . establishing a first signaling channel associated with said first communication device and said interactive response process (FIG. 1, FIG. 6C, FIG. 6D, column 42 lines 56-67, column 43 lines 1-6, column 224 lines 35-46) referenced by control signals H.323 from the Soft Switch 204 via Gateway Site 110 to the IVR 632 connecting telephone 120 to a Calling Card IVR Office Action, page 9.

The cited passage may teach signaling between Soft Switch 204 and Calling Card IVR 632, but it does not teach a signaling channel between a first communication device and an interactive response process, as recited in claim 47.

In response to Applicant's previous remarks along this line of reasoning, the Office Action states that "the audio media stream connection of the telephone 120 to the Calling Card IVR must first be setup via signaling without which there is no audio media stream connection." Office Action, page 28. However, Applicant respectfully asserts that control of an IVR may also be established, for example, through a media channel using DTMF tones over a media stream. Nothing in *Elliott* teaches or suggests that a signaling channel, and not a typical media stream or the like, is used to set up the calling card IVR. Therefore, contrary to the Examiner's assertion, a signaling channel is not required for the control of Calling Card IVR 632.

Claim 47 also recites, in part, “directing, under control of said interactive response process using said first signaling channel, a first media stream associated with said first communication device to said second communication device” The Office Action states that:

Elliott teaches . . . directing, under control of said interactive response process using said first signaling channel a first media stream associated with said first communication device to said second communication device (FIG. 2B) referenced by IVR in combination with Soft Switch 304 control of RTP/UDP/IP media stream between telephone 120 and Telephone 102
Office Action, page 9.

However, as noted above, nothing in *Elliott* explicitly teaches the IVR using a signaling channel to control a media stream. Furthermore, the recitation of calling card features in column 224 fails to teach or suggest any sort of control of media streams to accomplish these features.

Claim 47 further recites “receiving at said interactive response process signaling information from said first communication device indicating a desire to communicate with said operator system.” The Office states that:

Elliott teaches . . . receiving at said interactive response process signaling information from said first communication device indicating a desire to communicate with said operator system (column 223 lines 13-19) referenced by the first communication device accessing an operator by dialing “00” which is signaling information to connection to operator services. Office Action, page 9.

However, as noted above , the cited passage merely provides that:

Operator Services can be available to any customer using . . . calling card service . . . of the carrier of telecommunications network 200.” This passage also provides: “[a]n operator can be accessed by dialing “00” or 101-XXXX-0. Access to an operator can be accomplished through switched or dedicated access.”
Elliott, col. 223, lines 13-19.

Nothing in this recitation teaches that an indication of a desire to communicate with an operator system is received by an interactive response process, as recited by claim 47.

Rather, the cited passage of *Elliott* only indicates that operator access is provided through the carrier of telecommunications network 200.

In response to Applicant's previous remarks along this line of reasoning, the Office Action states that "[t]he method is only an example. Alternate methods of control transfer from a calling card IVR to operator services can be used to achieve operator service availability from the calling card IVR." Office Action, page 28. However, in order for a cited reference to be anticipatory, the identical invention must be shown in as complete detail and the elements must be arranged as claimed, see M.P.E.P. § 2131. Therefore, the mere assertion that alternate methods can be used does not provide appropriate support for the § 102 rejection. Accordingly, Applicant respectfully asserts that the rejection of independent claim 47 under 35 U.S.C. § 102 is improper and that for at least the reasons advanced above claim 47 is patentable over the § 102 rejection of record.

Claim 47 also recites, in part, "redirecting, under control of said interactive response process using said first signaling channel, said first media stream associated with said first communication device from said second communication device to said operator system" The Office Action states that:

Elliott teaches . . . redirecting, under control of said interactive response process using said first signaling channel, said first media stream associated with said first communication device from said second communication device to said operator system (column 225 lines 4-7) referenced by re-origination feature allowing the calling party of the first communication device to connect to operator service to originate a new call once the call to the second communication device is terminated. Office Action, page 9.

However, at the cited passage, *Elliott* only teaches that:

Re-Origination will allow customers to place multiple calling card calls without having to hang up, dial the access number, and enter the authorization code again. The feature can be initiated by depressing for 2 full seconds. *Elliott*, col. 225 lines 4-7.

Applicant reiterates that this passage from *Elliott*, directed to calling card services, does not provide any disclosure with respect to redirecting a media stream from a second

communication device to an operator system, particularly where this redirection is carried out under the control of an interactive response process using a first signaling channel between the first communication device and the interactive response process, as claimed.

Claim 47 further recites “directing a third media stream from said operator system to said first communication device.” The Office Action states that:

Elliott teaches . . . directing a third media stream from said operator system to said first communication device (column 225 lines 4-7) referenced by re-origination feature wherein the first communication device is connected to the operator service by depressing for 2 full seconds. Office Action, pages 9-10.

However, the passage cited by the Examiner does not provide any disclosure with respect to directing a third media stream from an operator system to a first communication device. In fact, the cited passage only provides that the re-origination feature “can be initiated by depressing for 2 full seconds,” not that a third media stream is directed from an operator system to the first communication device, as recited by claim 47.

For at least the foregoing reasons, Applicant respectfully asserts that independent claim 47 is patentable over the 35 U.S.C. § 102 rejection of record. Furthermore, there are great differences between claim 47 and the art of record, and a person of ordinary skill in the art considering the prior art would not find these differences obvious. Claims 48-54 and 56 depend directly, or indirectly, from base claim 47, and thus inherit all limitations of claim 47. As a result each of claims 48-54 and 56 set forth features and limitations not recited by *Elliott*. Thus, Applicant respectfully asserts that for at least the reasons advanced above in addressing the anticipation rejection of claim 47, claims 48-54 and 56 are patentable over the 35 U.S.C. § 102 rejection of record.

V. Rejections under 35 U.S.C. § 103(a)

Claims 23-33, 37, and 38 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Elliott* in view of *Cave*; and claims 34 and 35 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Elliott* and *Cave* in view of *Blair*. Applicant respectfully traverses these rejections for the reasons advanced below.

To establish a prima facie case of obviousness, three basic criteria must be met. See M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the second criterion, Applicant again respectfully contends that the Office Action fails to provide the requisite motivation to combine the references and that the references, if combined, fail to teach or suggest all the claim limitations.

A. The recited combination does not teach or suggest all claimed limitations.

Independent claim 23 recites, in part, “establishing a first signaling channel associated with said first communication device and said interactive response process” The Office Action states that:

Elliott teaches . . . establishing a first signaling channel associated with said first communication device and said interactive response process (FIG. 1, FIG. 6C, FIG. 6D, column 42 lines 56-67, column 43 lines 1-6, column 224 lines 35-46) referenced by control signals H.323 from the Soft Switch 204 via Gateway Site 110 to the IVR 632 connecting telephone 120 to a Calling Card IVR to obtain authorization code and destination number Office Action, pages 14-15.

As previously noted, the cited passage may teach signaling between Soft Switch 204 and Calling Card IVR 632, but it does not teach a signaling channel between a first communication device and an interactive response process, as recited in claim 23.

In response to Applicant’s previous remarks along this line of reasoning, the Office Action states that “a signaling channel must be established in order to connect the telephone to the Calling Card IVR since the IVR is an audio media stream based system. Without signaling, no connection can be made.” Office Action, page 27. However, Applicant respectfully asserts that the need for “signaling,” as advanced by the Examiner, is not the same as a need for a “signaling channel.” Control of an IVR may also be established, for example, through a media channel using DTMF tones over a media stream. Nothing in *Elliott* teaches or suggests that a signaling channel, and not a typical media stream, is used for

signaling. Therefore, contrary to the Examiner's assertion, a signaling channel is not necessarily required for the control of Calling Card IVR 632.

Claim 23 further recites, in part, "directing, under control of said interactive response process using said first signaling channel, a first media stream associated with said first communication device to said second communication device to thereby provide a call"

The Office Action states that:

Elliott teaches . . . directing, under control of said interactive response process using said first signaling channel a first media stream associated with said first communication device to said second communication device (FIG. 2B) referenced by IVR in combination with Soft Switch 304 control of RTP/UDP/IP media stream between telephone 120 and Telephone 102
Office Action, page 15.

However, as noted above, nothing in *Elliott* explicitly teaches the IVR using a signaling channel to control a media stream. Furthermore, the recitation of calling card features in column 224 fails to teach or suggest any sort of control of media streams to accomplish these features.

Neither *Cave* nor *Blair* is relied upon by the Office Action as teaching or suggesting any of the above discussed elements. Therefore, Applicant respectfully asserts that the combination of *Elliott* and *Cave*, nor the combination of *Elliott*, *Cave* and *Blair*, can be relied upon to teach or suggest at least the above discussed elements of claim 23. Thus, Applicant respectfully asserts that at least for the above reasons independent claim 23 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 24-35, 37 and 38 depend directly, or indirectly, from base claim 23, and thus each of claims 24-35, 37 and 38 inherit all limitations of claim 23. Therefore, for at least the reasons advanced above in addressing the obviousness rejection of claim 23, Applicant respectfully asserts that claims 24-35, 37 and 38 are also patentable over the 35 U.S.C. § 103(a) rejection of record.

B. The Office Action does not provide the requisite motivation.

The Office Action admits that *Elliott* does not teach a “whisper communication mode nor a recording function”. The Office Action attempts to cure this deficiency by introducing *Cave*, which the Office Action alleges to teach such a whisper mode and recording function. The motivation for making the combination was presented as follows:

It would have obvious ... to incorporate the whisper mode and recording function of the Voice Response Unit in *Cave* to the Interactive Voice Response Unit of *Elliot* for the purpose of recording both sides of the conversation or announce to both parties.

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. §2143.01. The language of the recited motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result. More particularly, the recited motivation indicates that it is obvious to incorporate a whisper mode into an IVR in order to “whisper” to call parties, and to incorporate a record function into an IVR in order to record. Such circular statements are merely statements that the references can be combined, and does not state any desirability for making the combination. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. §2143.01. Thus, the motivation provided by the Examiner is improper and insufficient, as the motivation must establish the desirability for making the combination.

Whereas, no valid suggestion has been made as to why a combination of *Elliott* and *Cave* is desirable, the rejection of claims 23-35, 37, and 38, each of which rely on the combination of *Elliott* and *Cave*, should be withdrawn.

VI. Conclusion


For all the reasons given above, Applicant submits that the pending claims distinguish over the prior art under 35 U.S.C. §§ 102 and 103. Accordingly, Applicant submits that this application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 06-2380, under Order No. 47524/P104CP1/09908773 from which the undersigned is authorized to draw.

Finally, Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that the attorney can be helpful in resolving any remaining issues in this case.

Dated: October 26, 2005

Respectfully submitted,

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